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JENNIFER GORDON
PENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NEW YORK 10036

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In re Application of
Gelfland et al.
Application No. 07/873,897
Filed: April 24, 1992
For: PURIFIED THERMOSTABLE ENZYME

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: DECISION DISMISSING
: PETITION
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This is a decision on the petition filed December 7, 1999 under 37 CFR 1.183, requesting waiver of the rules where they prohibit consideration of the Information Disclosure Statement (IDS) filed October 7, 1999, which date is subsequent to the mailing of a final Office action.

The petition is dismissed.

The IDS filed October 7, 1999 has been placed in the file.

Petitioner requests waiver of the rules in view of the six year period that the above-identified application underwent the appeal process, after the final Office action of March 19, 1993. Petitioner notes that the materials cited in the IDS were brought to applicants' attention during that period by way of the prosecution of foreign counterpart applications and also, patent litigation. Petitioner also complains that, due to the changes in the patent statutes in the same interval, now having to refile the application to ensure consideration of the IDS would wreak an unnecessary hardship due to the consequent loss of term in any forthcoming patent arising from a claim for benefit under 35 USC 120 in any continuing application, which would necessarily be filed after June 8, 1995.

Since the above-noted IDS has been submitted subsequent to the mailing of a final Office action on March 19, 1993, 1997, satisfaction of the requirements of 37 CFR 1.97(d)(1)-(3) was necessary for the IDS to now be considered. That is: (1) a certification in compliance with 37 CFR 1.97(e), (2) a petition requesting consideration, and (3) the \$130 fee set forth in 37 CFR 1.17(i), is necessary.

The regulations pertaining to the submission of an information disclosure statement (IDS) do not require that an IDS be filed, but rather, set forth the circumstances and conditions under which the Office will consider information promptly brought to its attention by applicant(s). Further, these circumstances and conditions are linked to the stage of prosecution at the time of submission of the IDS, as it is necessary for the Patent and Trademark Office (Office) to balance its need and desire to consider all information relevant to an application with its need for an efficient operation and its capability to consider information at various stages in the prosecution of an application.

In order for grant of any petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists in this case. Petitioner has not set forth an explanation for the belated submission of the IDS, much less attempted to demonstrate that the delay in submission was caused by "extraordinary circumstances" such that "justice requires" waiver of the requirement for certification set forth in 37 CFR 1.97(d)(1).

In this regard, the petition is silent as to when each piece of information in the IDS became known to petitioner, such that the three month period for submitting that specific piece of information was triggered. It is immaterial that the application was under final rejection and appellate review for an extended period of time, as such did not preclude petitioner from timely submission of each piece of information as it became available. See MPEP 609. Moreover, the PTO will undertake to consider information *throughout the pendency of an application* until the point where the issue fee has been paid, as long as the appropriate requirements of 37 CFR 1.97 are met at that stage of prosecution when the IDS is submitted. Id. at (B)(3).

Petitioner proffers no explanation for petitioner's protracted delay in bringing the items of information in the IDS to the attention of the PTO, such that the three month time period of 37 CFR 1.97(e) should be waived. That is, petitioner has not demonstrated that the protracted delay in submission of each of the items in the IDS was caused by circumstances beyond his control. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983). The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay. See, Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906)

and compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975).

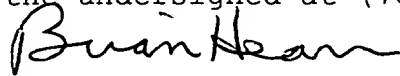
There is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of 37 CFR 1.97(e). See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers). Circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

Moreover, petitioner concededly has a suitable remedy on hand for his predicament, that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the PTO will not normally consider an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). As set forth in MPEP § 609(B)(3), (B)(4), applicants wishing to have the PTO consider an IDS, where, as apparently herein, the necessary certification cannot be made, should consider the filing of a continuing application, wherein the applicants may bring the references to the attention of the examiner without having to also tender a certification. While petitioner complains, due to the intervening change in the patent statute, about the loss of term should a continuing application be necessary to get the IDS considered, the underlying delay in submission of the IDS which may now necessitate such an action is that of petitioner, not the PTO. Rather, it is incumbent upon an applicant to prosecute his invention with continuing diligence and an acute awareness of the statute. See BEC Pressure Controls Corporation v. Dwyer Instruments, Inc., 380 F.Supp. 1397, 1399, 182 USPQ 190, 192 (D.C. N.Ind. 1974).

Moreover, the statutes and regulations do not compel an applicant to claim benefit under 35 USC 120 of any earlier case that might shorten the term of a forthcoming patent under 35 USC 154. However, should petitioner desire to be entitled to the potential benefits of earlier application(s) via 35 USC 120, then petitioner must also accept the consequences attendant to that action. See Abbott Laboratories v. Novopharm Ltd., 38 USPQ2d 1309, 1312 (D.C. N. 11. 1996), *aff'd* 104 F.3d. 1305, 41 USPQ2d 1535 (Fed. Cir. 1997).

This file is being forwarded to the Office of Publications for processing into a patent.

Telephone inquiries relevant to this decision may be addressed to the undersigned at (703) 305-1820.



Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects